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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/348,815      | 07/08/99    | LI                   | PF126P1D1           |

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HM12/0331

EXAMINER

ZARA, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1635     | 3            |

DATE MAILED: 03/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File Copy

**Office Action Summary**

Application No.

09/348,815

Applicant(s)

Li et al

Examiner

Zara, Jane

Group Art Unit

1635

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-20 are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION*****Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to an isolated polynucleotide, vectors comprising said polynucleotide, host cells transfected with said polynucleotide, classifiable in class 536, subclass 23.1 and in class 435 and subclasses 69.1, 320.1 and 365.
- II. Claims 11,12 and 19, drawn to a polypeptide, classifiable in class 530, subclasses 350 and 399.
- III. Claims 13, 14, 17 and 20, drawn to modulators of a receptor, classifiable in class 424, subclass 198.1.
- IV. Claim 15, drawn to a method of treatment comprising the administration of a polypeptide, classifiable in class 514, subclass 2.
- V. Claim 16, drawn to a method of treatment comprising the administration of a nucleic acid, classifiable in class 514, subclass 44.
- VI. Claim 18, drawn to methods of determining a nucleic acid mutation, classifiable class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II and III are independent and distinct, each from the other, because they are products which possess characteristic differences in structure, function and utility, which

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differences are distinct for each invention which cannot be exchanged. Therefore, the inventions of the two groups are capable of supporting separate patents.

Inventions IV, V and VI are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups IV and V comprise steps which are not required for or present in the methods of Group VI and vice versa.

Furthermore, the end result of the methods are different, and the operation, functions and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Groups I, II and III are biologically and functionally different and distinct from Groups IV, V and VI and thus one does not render the other obvious. The inventions can be shown to be distinct if either the process for using the product as claimed can be practiced with another materially different product or the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the DNA can be used for various functions including hybridization or cellular transformation, the polypeptides can be used for various functions including antibody production. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Zara whose telephone number is (703)-306-5820. The examiner's supervisory primary examiner is George Elliott who can be contacted at (703)-308-4003.



REMY YUCEL, PH.D  
PATENT EXAMINER

JZ

March 29, 2000